

REMARKS

The present Request for Continued Examination is made in response to the Office Action dated January 22, 2003 and identified as Paper No. 7. Claims 33-54 remain pending in the application.

In the Action, the Examiner objected to claims 37 and 49 as lacking an antecedent basis for "said output circuitry." Claims 43, 44, 51 and 53 were rejected under 35 U.S.C. §112, ¶ 1 as containing subject matter not described in the specification. Claims 45 and 53 were rejected under 35 U.S.C. 103(a) as obvious over the Examiner's personal experience in view of *In re Venner*, 363 F.2d 91, 120 USPQ 193 (C.C.P.A. 1958). Claims 45-48 and 53 were rejected under 35 U.S.C. § 103(a) as unpatentable over GB 2,274,184 to McIntosh ("*McIntosh*") in view of U.S. Patent No. 5,944,824 to He ("*He*"). Claim 49 was rejected under 35 U.S.C. § 103(a) as unpatentable over *McIntosh* and *He*, in further view of U.S. Patent No. 5,944,824 to Bang ("*Bang*"). Claims 50-52 and 54 were rejected as obvious over *McIntosh* and *He*, in further view of U.S. Patent No. 6,161,185 to Guthrie et al. ("*Guthrie*"). Claims 33-36, 38, 39, 40 and 41 were rejected as obvious over *McIntosh* and *He*, in further view of U.S. Patent No. 6,315,195 to Ramachandran ("*Ramachandran*"). Claim 37 was rejected as obvious over *McIntosh*, *He*, and *Ramachandran* in further view of Bang. Claim 42-44 were rejected as obvious over *McIntosh*, *He* and *Ramachandran*, in further view of *Guthrie*.

With regard to the objection to claims 37 and 49, the claims have been amended to depend from base claims that recite a proper antecedent basis.

With regard to the 35 U.S.C. § 112, ¶ 1 rejection of claims 43, 44, 51, and 53, claims 43 and 51 have been amended to delete the language "requiring said individual to

reply in order to continue using said device” considered by the Examiner to not be supported by the original disclosure. Claim 53 has been amended to clarify that indicia can be entered and associated passwords generated “for as many times as desired and permitted by said data storage source.”

With regard to the 35 U.S.C. § 103(a) rejection of claims 45 and 53 as obvious over the Examiner’s personal experience in view of *In re Venner*, the Examiner’s reliance on his personal method of tracking passwords using paper and pencil is improper. First, merely placing user IDs and passwords on a piece of paper does not disclose each and every element of the claimed invention, as required for a *prima facie* case of obviousness. In fact, this method of tracking IDs offer little to no security and is at complete odds with the purpose and intent of the present invention to protect against the unauthorized access that is prevalent by the use of such a rudimentary system. As expressly recited in claim 45, the present invention involves a portable body member; a data storage source contained in said body member; a user interface and communication componentry for permitting said individual to store in said data storage source a plurality of indicia each one of which is representative of a secured site; and password circuitry comprising a random number generator for randomly generating a plurality of passwords, wherein each of said plurality of passwords is uniquely associated with a respective one of said plurality of indicia. None of this claimed structure is disclosed by the Examiner’s purported “prior art” writing of passwords on a piece of paper.

Second, the Examiner has misinterpreted and misapplied the doctrine set forth in *Venner*. In *Venner*, the Court rejected a claim covering a molding process wherein one step of the method involved “time-controller means” which required skilled in the curing

process to determine and enter the appropriate time. 120 USPQ at 195. *Id.* As a result, the Court appropriately found that the claims could not cover the computation of the molding period if that step could be performed in the mind of one skilled in the process. *Id.* Thus, the claim was not rejected because it recited an automatic version of what was previously manual. Instead, the claim was rejected because it depended on the performance of a mental step as part of an automated process.

In *In re Rundell*, 48 F.2d 958, 9 U.S.P.Q. 220 (C.C.P.A. 1931), the case cited by *Venner* and indirectly relied on by the Examiner for the principle that one cannot claim an automated version of a manual process, the Court rejected an attempt to broadly claim as part of an automated process a rotating turret for holding cigar molds. The same turret, however, had been used in manual processes. *Id.* Thus, the claim was rejected because the structure was already known, not simply because the claim recited an automatic way of performing a manual process. The Federal Circuit has since confirmed that a claim directed toward an automated process that was previously performed by hand, or *vice versa*, could be patentable. *Alco Standard Corp. v. Tennessee Valley Authority*, 80 F.2d 1490, 1 U.S.P.Q.2d 1337 (Fed. Cir. 1986) (citing *Diamond v. Diehr*, 450 U.S. 175 (1981)). The present claims do not raise any considerations under this case law as the applicant is not attempting to claim either a process that involves a “mental step” that must be performed by one practicing the claims or a structure that is previously known.

With regard to the 35 U.S.C. § 103(a) rejection of claims 45-48 and 53 in view of *McIntosh* and *He*, the proposed combination does not state a *prima facie* case of obviousness for a rejection under 35 U.S.C. § 103(a). A rejection under 35 U.S.C. § 103(a) requires that each and every element of the claimed invention must be disclosed

by the combination of references. *See* MPEP § 2143.03. Additionally, there must be a suggestion or motivation in the references themselves or the knowledge of one skilled in the art to make the proposed combination. *See* MPEP § 2343.01. With regard to claim 45, the proposed combination of references does not disclose the claimed circuitry for randomly generating a password that is uniquely associated with each indicia stored in the device. In particular, *McIntosh* discloses a device for recording and recalling bank account pin numbers for use with bank ATM cards. The device has a security mode where, in response to an incorrect access password, it will randomly generate and display “fake” pin information so that an unauthorized user will use the fake password, thereby resulting in the retention of the ATM card by the bank machine. Thus, *McIntosh* does not disclose the generation of random passwords and must instead involve the storage and recall of the passwords that the banking institution previously generated and associated with the ATM cards.

He describes a secured network that allows the use of the same password across all network elements without the need to verify the password locally at each element. When a user logs on, a security server logs the user on to all network elements, rather than just the local element where the user is physically present. *He* creates a random password at the security server and transmits it to each network element for association with the user. In addition to lacking the random generation of a password for unique association with stored indicia representing a secured site, the electronic transfer of the user password in *He* is subject to electronic interception, unlike the generation of passwords in the handheld unit of the present invention that is entirely within the physical control of the user and secured independently from any network.

According to the Examiner, it would have been obvious to modify *McIntosh* to randomly generate passwords for association with various indicia based on the teaching in *He* of generating random passwords for users. It is unclear how a combination of *He* and *McIntosh* is even possible, as one reference involves a security system for a portable ATM pin memory device while the other relates to improving user accessibility by normalizing security operations across an entire computer network environment. It is insufficient that both references are in the same general field of art or even that they *may* be combined. See MPEP § 2143.01 (citing *In re Mills*, 916 F.2d 680, 16 U.S. P.Q.2d 1430 (Fed. Cir. 1990)). In fact, the references *cannot* be combined, as to do so would frustrate the sole purpose of *McIntosh*. MPEP § 2143.01. If the numbers stored in *McIntosh* were instead randomly generated and then associated with the stored bank account information, the device would never provide the proper ATM pin number and a user would never be able to access his bank account because the pin number generated by the device and provided to the user would not match the pin number that the bank has already assigned to the account.

The Examiner also failed to identify a proper motivation or suggestion to make the proposed combination of *McIntosh* and *He*. Although *He* discloses the use of a random generator for the creation of a password for each network user, the reference does not supply the requisite motivation to modify a separate mobile storage device to assign random passwords to multiple accounts or indicia. While *He* teaches generally that random passwords improve security, the Examiner did not explain how *He* motivates the proposed modification of the portable storage device in *McIntosh* to assign random passwords to associated indicia as claimed in the application. Even if the proposed

combination were possible, the references do not disclose each limitation recited in claim 45 as they do not teach the claimed association of passwords with indicia, nor do they contain a motivation to assign unique passwords to each such indicia. Thus, the conclusion that one would have been motivated to modify *McIntosh* to assign random passwords to stored indicia based on the mere disclosure of a network user password system in *He* is based on improper hindsight analysis, rather than any teaching in the references or in the art, and is therefore not a proper rejection under 35 U.S.C. § 103(a).

With regard to the 35 U.S.C. § 103(a) rejection of claim 49 as unpatentable over *McIntosh* and *He*, in further view of *Bang*, this claim depends from independent claim 45, which is otherwise allowable over the cited prior art.

With regard to the 35 U.S.C. § 103(a) rejection of claims 50-52 and 54 as obvious over *McIntosh* and *He*, in further view of *Guthrie*, claims 50-52 depend (either directly or indirectly) from claim 45 and should thus be allowable. Claim 54 depends from allowable claim 53.

With regard to the 35 U.S.C. § 103(a) rejection of claims 33-36, 38, 39, 40 and 41 as obvious over *McIntosh* and *He*, in further view of *Ramachandran*, elements f-h of independent base claim 33 are not rendered obvious with regard to the combination of *McIntosh* and *He*, as explained above, and all of the dependent claims should therefore be allowable.

With regard to the 35 U.S.C. § 103(a) rejection of claim 37 as obvious over *McIntosh*, *He* and *Ramachandran* in further view of *Bang*, elements f-h of independent base claim 33 are not rendered obvious with regard to the combination of *McIntosh* and *He*, as explained above, and all of the dependent claims should therefore be allowable.


With regard to the 35 U.S.C. § 103(a) rejection of claims 42-44 as obvious over *McIntosh*, *He* and *Ramachandran*, in further view of *Guthrie*., elements f-h of independent base claim 33 are not rendered obvious with regard to the combination of *McIntosh* and *He*, as explained above, and all of the dependent claims should therefore be allowable.

Submitted herewith is a Petition For a Two Month Extension of Time and a check in the amount of \$580 to cover the Petition Fee as well as the RCE filing fee.

The application as amended and supported by these remarks is believed to be in condition for allowance, the Examiner's consideration of which is respectfully requested. Should the Examiner feel that an interview with Applicant's representative would be useful in advancing the prosecution of this application, he is urged to contact the undersigned at 315-471-3151.

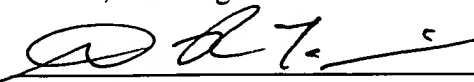
Respectfully submitted,

Joseph Grajewski

By 
George R. McGuire,
Reg. No. 36,603

Hancock & Estabrook, LLP
1500 MONY Tower I
P.O. Box 4976
Syracuse, NY 13221-4976
315-471-3151

I hereby certify that this correspondence is being placed with the U.S. Postal Service as First Class Mail on this April 22, 2003 addressed to Assistant Commissioner for Patents, Washington D.C. 20231


George R. McGuire

Dated: April 22, 2003